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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/715,176	11/20/2000	Charles E. Sigler JR.	XIUS-006XX	6429
207 7590 07/29/2008 WEINGARTEN, SCHURGIN, GAGNEBIN & LEBOVICI LLP TEN POST OFFICE SQUARE BOSTON, MA 02109				
EXAMINER				
WORJLOH, JALATIE				
ART UNIT		PAPER NUMBER		
3685				
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07/29/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

09/715,176

**Applicant(s)**

SIGLER ET AL.

**Examiner**

Jalatee Worjloh

**Art Unit**

3685

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12, 24 and 43-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12, 24, and 43-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 15, 2008 has been entered.
2. Claims 1-12, 24, and 43-52 are pending.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-12, 24, and 43-52 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, Applicants amended the claims to recite "an indicator of one of a plurality of different payment methods", "wherein said one of said plurality of different payment methods for purchasing the product is unknown to the seller", "in a querying step, ...said one of said plurality of different payment methods form the received anonymous identifier, wherein, prior to said querying of the digital repository by the trusted third party, said one of said plurality of different payment methods for purchasing the product is unknown to the

trusted third party"; however, the specification does not provide support for these features.

Applicants cited page 17, lines 7-9 as expressing support for these features, but the limitations are not support. If Applicants disagree, please clearly identify there these features are taught.

***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-14 and 43-52 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Based on Supreme Court precedent<sup>1</sup> and recent Federal Circuit decisions, § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing.<sup>2</sup> If neither of these requirements is met by the claim(s), the method is not a patent eligible process under 35 U.S.C. § 101.

In this particular case, the claims are not tied to another statutory class.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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<sup>1</sup> *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

<sup>2</sup> The Supreme Court recognized that this test is not necessarily fixed or permanent and may evolve with technological advances. *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972).

8. Claims 1-14 and 43-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 7398253 to Pinnell and US Patent No. 7127427 to Casper in view of US Patent No. 6539364 to Moribatake et al. ("Moribatake").

Referring to claims 1-4 and 6-8 Pinnell discloses receiving, by a trusted third party from the buyer, an indicator of one of a plurality of different payment methods, wherein said one of said plurality of different payment methods is one or more credit card, debit card, an e-check, and a direct debit account (see col. 6, lines 24-40 – the customer has several payment options to select; the customer selects the type of payment to use for each transaction), assigning an anonymous identifier to the indicator that corresponds to said one of said plurality of different payment methods, wherein the anonymous identifier is a one-time use code and a unique code, wherein the anonymous identifier is assigned by at least one of the buyer and the seller (see col. 4, lines 58-67 – a temporary credit card number and expiry date is assigned), populating, by the trusted third party, a digital repository with data that is associated with the buyer (see col. 5, lines 1-3 and 51-66 – the application creates records for the transaction to be authorized and the single-use, temporary payment instrument), receiving, by the trusted third party from a seller, the total sale price for payment approval of the product the buyer is purchasing, wherein said one of said plurality of different payment methods for purchasing the product is unknown to the seller, and providing payment approval to the seller (see col. 7, lines 16-25). Pinnell does not expressly disclose the data including a buyer identification indicator, the indicator of the respective payment method, and the anonymous identifier; receiving, by the trusted third party from the buyer, the anonymous identifier as an anonymous payment method for a product the buyer is purchasing, the product having a total sale price; in a querying step, querying, by the trusted third

party, the digital repository to determine said one of said plurality of different payment methods from the received anonymous identifier, wherein, prior to said querying of the digital repository by the trusted third party, said one of said plurality of different payment methods for purchasing the product is unknown to the trusted third party, requesting, by the trusted third party, payment approval from a payment partner by providing the payment partner a description of the respective payment method determined in the querying step and the total sale price. Casper discloses populated data including buyer identification indicator, the indicator of the respective payment method, and an anonymous identifier (see col. 8, lines 25-29), in a querying step, querying, by the trusted third party, the digital repository to determine said one of said plurality of different payment methods from the received anonymous identifier, wherein, prior to said querying of the digital repository by the trusted third party, said one of said plurality of different payment methods for purchasing the product is unknown to the trusted third party, requesting, by the trusted third party, payment approval from a payment partner by providing the payment partner a description of the respective payment method determined in the querying step and the total sale price, wherein the payment partner is a credit processor that receives credit approval from a credit approval authority, wherein the payment partner is a credit approval authority (see col. 8, lines 63-67 & col. 9, lines 1-4, 40-48). Moribatake discloses receiving, by the trusted third party from the buyer, the anonymous identifier as an anonymous payment method for a product the buyer is purchasing, the product having a total sale price (see abstract). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method taught by Pinnell to include the elements of Casper and Moribatake. One of

ordinary skill in the art would have been motivated to do this because it protects a purchaser's identity during electronic transactions, thereby reducing fraudulent purchases.

Referring to claim 5, Pinnell discloses the anonymous identifier (see claim 1 above). Pinnell does not expressly disclose the anonymous identifier. However, the difference is only found in the nonfunctional descriptive material and is not functionally involved in the receiving, assigning, populating, and receiving steps recited. The steps would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 UPSQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to receive, assign, populate and receive any type of data because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

Pinnell in combination with Casper and Moribatake discloses the method wherein the paying step comprises making micropayments to the seller (see claim 9 rejection).

Claims 9-12 and 14 are rejected on the same rationale as claims 1 and 5-8 above.

Claim 24 is rejected on the same rationale as claim 1 above.

Claims 43-49 are rejected on the same rationale as claims 1- 7 above.

Claim 52 is rejected on the same rationale as claim 1 above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is 571-272-6714. The examiner can normally be reached on Monday - Friday 10:00 - 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt II can be reached on 571-272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jalatee Worjloh/  
Primary Examiner, Art Unit 3685